

1. REMARKS / DISCUSSION OF ISSUES

Claims 21-42 are presently pending in the application. Claims 21 and 33 are the independent claims. The claims are not amended in the present Response. As such a listing is neither required nor provided under Rule 121.

Rejections under 35 U.S.C. § 102

Claims 21, 22, 29 and 33, 34 are rejected under 35 U.S.C. § 102(e) as being unpatentable over *Teng, et al.* (US Patent 6,094,679). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Claims 21 and 33

Claim 21 is drawn to a system and features:

“...a configuration server that responds to the HTTP request by generating an HTTP response on the communication network such that the HTTP response carries configuration data to the device.”

Claim 33 is drawn to a method and includes a similar feature.

The Office Action directs Applicants to column 6, lines 39-67, column 7, lines 1-28 and Figs. 2-4 for the alleged disclosure of the referenced features of claims 22 and 33.

a. The Office Action fails to comply with MPEP § 706

MPEP § 706 states, inter alia:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action.

Applicants respectfully submit that the Examiner has not articulated with sufficient specificity the alleged disclosure of the generation of the HTTP response. Notably, the portions of the Office Action relied upon describe the sending of a request from a client 20 to a network server 49. Specifically, there is no description of where a response to the request is discussed in the portions of columns 6 and 7 relied upon in the Office Action. Applicants respectfully request that the Examiner state with specificity where the reference allegedly discloses the claimed response.

b. Teng, et al. does not disclose the featured response

Applicants have reviewed this portion of the disclosure as well as the remaining portions of column 7 and all of column 8 and have not uncovered the disclosure of the generation of an HTTP response. Moreover, even if there were a disclosure of the HTTP response generation, there is no disclosure of the HTTP response's carrying the configuration data. Specifically, at column 8, beginning at line 36, the reference discloses:

In particular, with reference to FIG. 7, the server scripting component 76 queries in step 124 the system spooler 80 to retrieve therefrom the printer driver software files for the specified printer, in this example printer 50. In connection with this retrieval, the information contained in the data field appended to the HTTP formatted request message pertaining to the form of the platform of the network client 20 may be utilized by the server scripting component 76 to direct the system spooler 80 as to exactly which printer driver software files to return in response to the query, i.e., only those drivers which can operate in conjunction with the version of the particular operating system and processor architecture of the network client 20 are to be returned.

At column 9, beginning at line 41, the reference describes compressing of files into a cabinet file and returning same to the network client. However, there is no disclosure of *generating an HTTP response on the communication network such that the HTTP response carries configuration data to the device* as specifically recited in claim 22.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of each of claims 22 and 33. Therefore, a *prima facie* case of anticipation has not been established. Thus, claims 22 and 33 are patentable over the applied art. Moreover, claims 23-32 and 34-42, which depend from claims 21 and 33, respectively, are patentable for at least the same reasons and in view of their additionally recited subject matter.

Rejections under 35 U.S.C. § 103

Applicants have considered the rejections of claims 23-32 and 34-42 under this section of the Code in view of *Teng, et al.* and secondary references. As noted, these claims depend from independent claims 22 and 33, directly or indirectly. Therefore, and while in no way conceding the propriety of the rejections, Applicants respectfully submit that these claims are patentable over the applied art at least because of their dependence on respective independent claims.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Agilent Technologies, Inc.

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by: William S. Francos (Reg. No. 38,456)

Date: January 17, 2008

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